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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,976	02/09/2004	Wayne Belcher	20108/0200867-US0	9594
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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER LUK, EMMANUEL S	
			ART UNIT 1722	PAPER NUMBER
			MAIL DATE 06/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,976

Applicant(s)

BELCHER, WAYNE

Examiner

Emmanuel S. Luk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,11,13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11,13,15-17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8, 10-11, 13, 15-17, and 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, independent claims 1 and 21 both contain the limitation so the elongated applicator portion with:

“about the longitudinal axis with external angles formed by the adjacent external surfaces of the applicator portion being *less than or equal to 270 degrees*, and the lateral edges each comprise a surface that is perpendicular to a plane encompassing the longitudinal axis and the substantially spline radius.”

The features above are not described in the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 8, 16, 17, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Julien (6293020).

Julien teaches a tool having a handle with substantially planar configuration (42) with an elongated applicator portion (34) that is fixed at one end with the handle and transitioning linearly outward along a longitudinal axis of the handle and applicator portion (Fig. 1, Fig. 2), and further transitioning toward a single free end tip (52) and decreases from the longitudinal axis towards lateral edges of the applicator portion (Fig. 1, Fig. 2, Fig. 3), the external surface of the applicator portion is symmetrically convex with an aggressive shaped curvature (52).

The use of the tool for sealant application is an intended use of the apparatus. Julien teaches the structures of the claimed invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2, 3, 6, 7, 10, 11, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julien as applied to claim 1 above, and further in view of Arnett (DE 31965).

Julien fails to teach the handle and applicator from the same material and integrated and a passive curvature and that the applicator decreases linearly longitudinally. Julien does teach of the knife blank 350 having the shape of the blade and the handle prior to additional material is placed upon for ease of grip (Fig. 30).

Arnett teaches a tool having a handle (1) of a planar configuration, and a planar applicator portion (2) that is fixed to the handle with a free tip section (4) having a spline radius. The handle and applicator portion are the manufactured the same and are integrated. The tip having a passive shaped curvature and the handle surface appears smooth.

It would have been obvious for one of ordinary skill in the art to modify Julien with the passive curvature shape as taught by Arnett because it is a design choice in the shape of the tip. In regards to the handle and blade being of one integrated material, Arnett teaches a blade that is capable of being constructed and thus it would have been

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obvious for one ordinary skill in the art to modify Julien with the handle and applicator being the same material as taught by Arnett because of ease in manufacturing.

In regards to claim 6, Arnett does teach a decrease of the applicator longitudinally though not linearly. This is a change in shape for the design and have the same equivalent function as the features of Julien that one of ordinary skill in the art would recognize as being equivalent.

In regards to claims 13 and 15, these are dimensions to the tool that can be varied according to design choice. Claim 16 is also based primarily upon design and user choice since comfortable gripping is determined more upon the particular user.

8. Claim 5 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julien as applied to claims 1 and 21 above, and further in view of Cacossa (5759590).

Julien fails to teach the construction material of the handle and the applicator.

Cacossa teaches that the handle can be made out of plastic, wood, metal, or the like (Col. 4, lines 22-26), and the blade structure can be made from metallic material, from plastic, or other substantially rigid material (Col. 4, lines 27-35).

It would have been obvious to one of ordinary skill in the art that the tool taught by Arnett is made from a material such as plastic or metal as these are common materials to construct tools.

Response to Arguments

9. Applicant's arguments, filed 4/10/07, with respect to the rejections of the claims under Julien have been fully considered but are not persuasive. The applicants include argument concerning the external edges of Julien and have amended the claims with external angles in which the Examiner have unable to find in the specification. The arguments have been considered, however, the arguments fall upon features that are new matter. The applicator of Julien is symmetrical particularly along the tip portion and the serrations are along one edge, the general shape is symmetrical.

The arguments by the applicants are unpersuasive and the rejections stand.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel S. Luk whose telephone number is (571) 272-1134. The examiner can normally be reached on Monday-Fridays from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EL

Tim Heitbrink
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PRIMARY EXAMINER
GROUP 130/1722
6-23-07